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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,667	10/30/2000	Jean-Pierre Perreault	258/235	8852
34026	7590	11/15/2005	EXAMINER	
JONES DAY 555 SOUTH FLOWER STREET FIFTIETH FLOOR LOS ANGELES, CA 90071				ZARA, JANE J
		ART UNIT		PAPER NUMBER
		1635		

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/699,667	PERREAULT ET AL.
	Examiner	Art Unit
	Jane Zara	1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 September 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,4-6,8,10-17 and 31-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4-6,8,10-17 and 31-43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4-23-01</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the communication filed 9-7-05.

Claims 1, 4-6, 8, 10-17 and 31-43 are pending in the instant application.

Election/Restrictions

The restriction requirements pertaining to the election of a single sequence mailed on 7-3-02, 11-20-03 and 4-8-05 are hereby withdrawn. SEQ ID Nos. 65 and 66, listed in claim 20 (filed 12-22-04), are generic to a plurality of disclosed patentably distinct species comprising SEQ ID Nos. 61-64, and including the substrate binding site sequences listed as *i-x* in claim 23 (filed 12-22-04). These sequences have been rejoined and examined on their merits as set forth below.

Response to Arguments and Amendments

Withdrawn Rejections

Any rejections not repeated in this Office action are hereby withdrawn.

Maintained Rejections

Claims 1, 4-6, 8, 10-17 and 31-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of the nucleic acid enzymes claimed cannot be determined from the language of the claims (Please see the written description rejection set forth below).

Claims 1, 4-6, 8, 10-17 and 31-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the reasons of record set forth in the Office action mailed 6-16-04, and for the reasons set forth below.

Applicant's arguments filed 9-7-05 have been fully considered but they are not fully persuasive. The instant claims set forth a description of nucleic acid enzymes that are derived from hepatitis delta virus, and which comprise the generic sequence set forth in SEQ ID Nos. 65 and 66, which sequences are presumed to be contiguous sequences within a single molecule. The claims set forth various higher order structural characteristics that are inherent in the nucleic acid enzymes encompassed by the generic sequences of SEQ ID Nos. 65 and 66. In view of the instant disclosure and the prior art, there appears to be adequate written description for the nucleic acid enzymes encompassed by the [contiguous] sequences of SEQ ID Nos. 65 and 66, and including SEQ ID Nos. 61-64 and the substrate binding site sequences set forth in *i-x* of previously filed claim 23 (filed 12-22-04). The claims filed 9-7-05, however, lack adequate written description because they set forth secondary structural characteristics of the nucleic acid enzymes claimed, but they omit the concise structural features and elements that are essential to the claimed invention (e.g. the SEQ ID Nos. 65 and 66,

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which are presumed to be contiguous sequences within the same molecule). The scope of the instant claims embrace a myriad of structures, and no common structural attributes adequately identify or concisely describe the structural attributes encompassed by the claimed genus. The common attributes and/or characteristics concisely identifying members of the proposed genus are exemplified by the generic and contiguous sequences of SEQ ID Nos. 65 and 66.

Allowable Subject Matter

SEQ ID Nos. 61-64, and including the substrate binding sites listed as I-x in the claim 23 filed 12-22-04, appear free of the prior searched and of record.

The following is a statement of reasons for the indication of allowable subject matter: The nucleic acid enzymes encompassed by the claimed genus are derived from hepatitis delta virus, and comprise the generic sequence set forth in SEQ ID Nos. 65 and 66, which sequences are presumed to be contiguous sequences within a single nucleic acid enzyme molecule. The generic sequences set forth in SEQ ID No. 65 and 66 are adequately described in the instant disclosure and are exemplified in SEQ ID Nos. 61-64, and in figures 1-7 (e.g. SEQ ID Nos. 44-46, 53, 58, 59).

Conclusion

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94

(December 28, 1993) (see 37 C.F.R. 1.6(d)). The official fax telephone number for the Group is **571-273-8300**. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is **(571) 272-0765**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (571) 272-0564. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jane Zara
11-9-05

Jane Zara
TC, 600